

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Steve J. McKinnon

Serial No. 10/034,431

Filed: 12/27/2001

For: **DYNAMIC PRESENCE MANAGEMENT**

Examiner: Hossain, Tanim M.

Art Unit: 2145

Mail Stop Appeal Brief – Patents

Commissioner for Patents

PO Box 1450

Alexandria, VA 22313-1450

Sir:

A **SUPPLEMENTAL REPLY BRIEF** is filed herewith. If any fees are required in association with this Reply Brief, the Director is hereby authorized to charge them to Deposit Account 50-1732, and consider this a petition therefor.

SUPPLEMENTAL REPLY BRIEF

A. Introduction

The questions on appeal are whether the Patent Office has provided a *prima facie* case that claims 1-8, 11-22, 25-34, 37, and 38 are anticipated under 35 U.S.C. § 102(e) by U.S. Published Application No. 2002/0143876 to Boyer et al. (hereinafter “Boyer”), and that claims 9, 10, 23, 24, 35, and 36 are obvious under 35 U.S.C. § 103(a) over Boyer in view of U.S. Published Application No. 2002/0035605 to McDowell et al. (hereinafter “McDowell”). For the rejections under 35 U.S.C. § 102(e), the Patent Office has not shown where all of the elements of independent claims 1, 15, and 27 are shown with the requisite particularity to sustain an anticipation rejection. For the rejections under 35 U.S.C. § 103(a) in light of Boyer and McDowell, the Patent Office has failed to establish *prima facie* obviousness. Neither Boyer nor McDowell, alone or in combination, teach or suggest creating the service logic at the presence detection system and providing the service logic from the presence detection system to the presence service as recited in the claims of the present invention.

Appellant files this Supplemental Reply Brief to respond to the Examiner’s Answer filed August 23, 2007. Appellant previously filed an Appeal Brief on March 14, 2006. The Patent Office responded with an Examiner’s Answer mailed on June 16, 2006. Appellant then filed a Reply Brief on August 16, 2006. The Board of Patent Appeals and Interferences mailed an Order Returning Undocketed Appeal to Examiner on March 28, 2007, holding Appellant’s March 14, 2006 Appeal Brief defective for failing to comply with 37 CFR § 41.37 (c)(1)(v) because the Appeal Brief did not provide mapping of the independent claims. In response, Appellant filed a Revised Appeal Brief on May 16, 2007, amending section (5) SUMMARY OF CLAIMED SUBJECT MATTER to provide mapping of the independent claims. The Patent Office then mailed a new Examiner’s Answer on August 23, 2007. The August 23, 2007 Examiner’s Answer was substantially similar to the Examiner’s Answer mailed June 16, 2006, with the only exception being a new issue raised as to the use of service logic being an inherency in all client-server communication (see Examiner’s Answer mailed August 23, 2007, p. 8, l. 16 through p. 9, l. 6).

Appellant hereby submits this Supplemental Reply Brief to respond to this new issue as raised in the Examiner’s Answer filed August 23, 2007. Appellant also relies on its previous

arguments as set forth in the Revised Appeal Brief filed May 16, 2007 and the Reply Brief filed August 16, 2006, and incorporates the same by reference.

B. Argument

1. The Patent Office is Not Permitted to File a Supplemental Examiner's Answer Raising New Issues

As an initial matter, Appellant respectfully submits that the Patent Office is not permitted to file a supplemental Examiner's Answer raising new issues. 37 CFR §1.93(b)(1) states that an appellant may file a reply brief to an examiner's answer and that the primary examiner must acknowledge receipt and entry of the reply brief or reopen prosecution. "A supplemental examiner's answer is not permitted, unless the application has been remanded by the Board of Patent Appeals and Interferences for such purpose." 37 CFR §1.93(b)(1); see also MPEP 1208.03. In the present case, the Board of Patent Appeals and Interferences' March 28, 2007 Order Returning Undocketed Appeal to Examiner ordered the application be returned to the Examiner for the following purposes: to hold Appellant's March 16, 2006 Appeal Brief defective; for the Appellant to file a substitute Appeal Brief in compliance with 37 CFR § 41.37; and for the Examiner to consider the substitute Appeal Brief and, **if necessary**, vacate the Examiner's Answer mailed June 16, 2006 and issue a revised Examiner's Answer (Board of Patent Appeals and Interferences' Order Returning Undocketed Appeal to Examiner mailed March 28, 2007, p. 2, emphasis added). The Revised Appeal Brief filed by Appellant on May 16, 2007, was identical to the original Appeal Brief filed March 14, 2006, with the only change being amendments to section (5) SUMMARY OF CLAIMED SUBJECT MATTER to provide mapping of the independent claims. Thus, the Revised Appeal Brief filed by Appellant on May 16, 2007 did not necessitate the inclusion of the new issues raised on pages 8 and 9 of the Examiner's Answer mailed August 23, 2007. The amendments to the SUMMARY OF CLAIMED SUBJECT MATTER did not necessitate the new arguments regarding the use of service logic being an inherency in all client-server communication. Thus, since the Board's Order allowed the Examiner to issue a revised Examiner's Answer only if necessary after consideration of the substitute Appeal Brief, and the revised Examiner's Answer added arguments not necessary to respond to the changes made in the substitute Appeal Brief, those

arguments added on pages 8 and 9 of the Examiner's Answer mailed August 23, 2007 are improper under 37 CFR §1.93(b)(1) and should not be considered by the Board.

2. It is Not Inherent in Boyer that Service Logic is Created at the Presence Detection System

Even if the Examiner's new arguments on pages 8 and 9 of the Examiner's Answer mailed August 23, 2007 are proper, a point Appellant does not concede, the new arguments do not change the fact that Boyer fails to teach receiving state information and creating service logic based on this state information at the presence detection system, as recited by the claimed invention. The Patent Office contends that the use of service logic is an inherency in all client-server communication, and indeed, all computer functions (Examiner's Answer mailed August 23, 2007, p. 8). Appellant has previously stated that it does not dispute that there is service logic in Boyer's system; but that Boyer does not teach that the service logic is created at the presence detection system, as recited in the claims, because Boyer teaches that the service logic is created in the SPFS (Revised Appeal Brief filed May 16, 2007, p. 8).

The Patent Office also states that "Service logic is therefore all-encompassing in all computer function, all client-server communications, and therefore, all functions disclosed in Boyer." (Examiner's Answer Mailed August 23, 2007, pp. 8-9). To the extent that the Patent Office is arguing that service logic is inherently found in every function in Boyer and therefore, Boyer inherently teaches that service logic is created at the presence detection system, Appellant respectfully disagrees. "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 U.S.P.Q.2d (BNA) 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. MPEP 2112, citing *In re Rijckaert*, 9 F.3d 1531, 1534, 28 U.S.P.Q.2d (BNA) 1955, 1957 (Fed. Cir. 1993). Applicant respectfully submits that creating service logic at the presence detection system is not inherent just because service logic may be common in computers or client-server communications. The fact that service logic may be well known in client-server communications does not necessarily lead to the conclusion that service logic would be created at the presence detection system.

Therefore, it is not inherent in Boyer that the service logic is created at the presence detection system, as recited in the claims. This is especially true since the service logic in Boyer is created in the SPFS, which is not equivalent to the claimed presence detection system (see Revised Appeal Brief filed May 16, 2007, pp. 8-9; and Reply Brief filed August 16, 2006, pp. 2-3).

Since the claims require the creation of the service logic to be at the presence detection system, and Boyer only discloses the service logic of the SPFS, independent claims 1, 15, and 27 are not anticipated. Further, claims 2-8, 11-14, 16-22, 25, 26, 28-34, 37, and 38, which depend on claims 1, 15, and 27, are not anticipated by Boyer.

3. Boyer Does Not Teach Providing the Service Logic from the Presence Detection System to an Associated Presence Service to Distribute Generation of the Service Logic

Boyer also fails to disclose providing the service logic from the presence detection system to an associated presence service to distribute generation of the service logic. Since the Patent Office maintains that the SPFS is part of the presence detection system, then Boyer does not teach providing the service logic from the presence detection system to the associated presence service as recited in the claims (see Revised Appeal Brief filed May 16, 2007, pp. 8-9; Reply Brief filed August 16, 2006, pp. 3-4). The Patent Office asserts that the service logic is distributed to the ConnectIcon View, TeamPortal View, etc., which are the applications that provide the interface through which the human client may communicate with the user. Thus, the Patent Office is equating these applications to the claimed associated presence service. The applications disclosed in Boyer (ConnectIcon View, TeamPortal View, etc.) are not equivalent to the claimed associated presence service. In fact, ConnectIcon View, TeamPortal View, and the like, are actually presence clients (Boyer, paragraph 0040). A person of ordinary skill in the art reading Applicant's specification would not reasonably interpret the presence clients of Boyer to be equivalent to the claimed associated presence service. Since Boyer does not teach the associated presence service of the claimed invention, Boyer cannot teach providing the service logic from the presence detection system to the associated presence service to distribute generation of the service logic. Thus, Boyer does not anticipate the present invention for this additional reason.

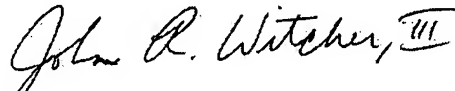
C. Conclusion

Boyer fails to disclose or suggest receiving state information bearing on the presence of a user and creating service logic based on the user at a presence detection system. The fact that service logic may be well known in client-server communications does not necessarily lead to the conclusion that service logic would be created at the presence detection system. Therefore, it is not inherent in Boyer that the service logic is created at the presence detection system, as recited in the claims. Boyer further fails to disclose providing the created service logic from the presence detection system to an associated presence service. McDowell also fails to disclose or suggest these elements. As such, Boyer and McDowell, alone or in combination, fail to disclose or suggest the claimed invention. Appellant respectfully requests that the Board reverse the Examiner and instruct the Examiner to allow the pending claims 1-38.

Respectfully submitted,

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